

Serial No.: 09/918,188  
Art Unit: 2137**REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed January 5, 2006. Reconsideration and allowance of the application and presently pending claims 1-2, 7-17, 21-22, 25-37, 39-43, 48-49, 51-59, and 63 are respectfully requested.

**1. Response to Rejection of Claims Under 35 U.S.C. §112, First Paragraph**

Claims 64-65 have been rejected under 35 U.S.C. §112, First Paragraph for allegedly containing subject matter which is not adequately described in the specification. Claims 64-65 have been canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot.

**2. Response to Rejection of Claims Under 35 U.S.C. §112, Second Paragraph**

Claim 21 has been rejected under 35 U.S.C. §112, Second Paragraph for allegedly not distinctly claiming the subject matter of the claim. In particular, the Office Action states that it is unclear as to how the session key is encrypted and decrypted. Applicants respectfully believe that the claim is in compliance with 35 U.S.C. §112, Second Paragraph.

In addressing the question raised in the Office Action, the session key is encrypted using a first token and is decrypted using a second token. For example, in one embodiment, among others, a first token could be a public key and the second token could be a private key, or vice versa. Applicants, therefore, believe this explanation should overcome the rejection and respectfully request withdrawal of the rejection.

Claim 63 has been rejected under 35 U.S.C. §112, Second Paragraph for depending from a claim that had been previously canceled. Accordingly, claim 63 has been amended to overcome the rejection. Applicants respectfully request withdrawal of the rejection.

**3. Response to Rejection of Claims Under 35 U.S.C. §102**

In the Office Action, claims 54-56 and 58-59 stand rejected under 35 U.S.C. §102(e) as allegedly being unpatentable by *Chan* (U.S. Patent No. 6,378,070) and *Mandelbaum* (EP Pat. Pub. No. 0671830A2). For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the

**BEST AVAILABLE COPY**

Serial No.: 09/918,188  
Art Unit: 2137

claim. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

Applicants respectfully submit that independent claim 54 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining the transmitted document at the second station prior to receiving proof of the intended recipient's identity and receiving the data record at the second station," as recited in claim 54.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining the transmitted document at the second station . . . and receiving the data record at the second station," as recited in claim 54, since the document store is not co-located with a printer in *Chan*. (Emphasis added). Thus, *Chan* does not anticipate claim 54, and the rejection should be withdrawn.

The Office Action states that *Chan* clearly discloses retaining a document at the printout station in accordance with a security process. Applicants respectfully disagree. *Chan*, rather, clearly states that a print job is "transmitted to a print server (130), where the print job is held." See Abstract. Further, *Chan* states that a print spooler or server is arranged to "recognise encrypted documents and, rather than forwarding them to a specific printer, [they] hold or store the encrypted documents." Cols. 3-4, lines 62-5. Thus, *Chan* does not teach or suggest that a second station, where a recipient provides proof of his or her identity, securely retains the document, in a manner described in the claim.

Further, *Chan* describes a process where a user identifies himself or herself at a printout station and then a check is performed to determine if any documents stored at the print server are intended for the user. If so, the documents are then forwarded to the printout station. As such, *Chan* fails to teach or suggest at least the steps "transmitting the document to the second station prior to receiving proof of an intended recipient's identity" and "receiving and securely retaining the transmitted document at the second station prior to receiving proof of the intended recipient's identity and receiving the data record at the second station." For at least these reasons, *Chan* fails to anticipate the claim.

With regard to *Mandelbaum*, Applicants respectfully submit that independent claims 54 is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or

Serial No.: 09/918,188  
Art Unit: 2137

suggest "determining prior to transmission of the document whether the second station is one which is arranged to stop a transmitted document from being released until the intended recipient has proved their identity, wherein the first station is configured to alternatively transmit the document as a non-encrypted transmission when the second station is determined to not be capable of stopping a transmitted document from being released until the intended recipient has proved their identity," as recited in claim 54. For example, *Mandelbaum* does not teach or suggest checking capabilities of a second station for implementing the transmission and encryption techniques of the claimed subject matter, where an alternative mode may be used if the second station is not capable of handling transmission techniques of a first station. Therefore, *Mandelbaum* does not anticipate claim 54 and the rejections should be withdrawn for at least this reason. In this respect, *Chan* also fails to teach or suggest these features.

Because independent claim 54 is allowable over the cited art of record, dependent claims 55-56 and 58 (which depend from independent claim 54) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

#### 4. Response to Rejection of Claims Under 35 U.S.C. §103

In the Office Action, claims 1-2, 8-10, 13-17, 22-24, 41-43, and 48-53 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Nishiwaki* (U.S. Patent No. 5,602,973) and *Mandelbaum* in view of *Nishiwaki*. Claim 7 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Nishiwaki* and *Chan* in view of *Nishiwaki* in further view of *Menezes* (Handbook of Applied Cryptography). Claims 11-12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Nishiwaki* in further view of *Schneier* (Applied Cryptography). Claim 11 also stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Nishiwaki*. Claim 12 also stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Nishiwaki* in view of *Schneier*. Claims 21, 25-37, and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Carman* (U.S. Patent No. 6,272,632) and *Mandelbaum* in view of *Schneier* in further view of *Carman*. Claims 22-24 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view

Serial No.: 09/918,188  
Art Unit: 2137

of *Nishiwaki* and *Mandelbaum* in view of *Schneier* in further view of *Carman*. Claim 40 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Carman* and *Mandelbaum* in view of *Carman*. Claims 57 and 63 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Schneier* and *Mandelbaum* in view of *Schneier*. Claim 59 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* (European Patent Application Publication No. 0798892 A2). Claims 64-65 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Schneier*.

a. Claims 1-2 and 7-17

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 1.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 1, since the document store is not co-located with a printer in *Chan*. (Emphasis added). *Chan* also teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient proves their identity.

With regard to *Nishiwaki*, it teaches that a printer unit sends to a host device the identification of a bin where a document is deposited and either provides a personal identification number for the bin or the personal identification number is provided by the sender of the document. Neither of these provides proof of the identity of an intended recipient, as described in the claim. See col. 6, lines 23-65. Accordingly, the proposed combination of *Chan* in view of *Nishiwaki* fails to teach or suggest "releasing the document when the intended recipient has proved their identity [at the printout station] by use of a second token that is uniquely related to the first token, wherein the retaining step comprises printing out the document as received and placing it in a locked compartment

Serial No.: 09/918,188  
Art Unit: 2137

and the releasing step comprises a controller unlocking the compartment where the printed copy of the document is stored."

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to already printed documents. For example, *Mandelbaum* teaches that a user is to be present at a print unit for the document to be printed. Therefore, *Mandelbaum* provides no motivation or suggestion of having a document placed in a locked compartment of a printer unit that is to be accessed by a user, when *Mandelbaum* teaches that the user must be present at the printer unit for the document to be printed in the first place. Further, the inadequacies of the *Nishiwaki* reference, as described above, also apply with regard to the proposed combination with *Mandelbaum*.

For at least these reasons, the proposed combinations of *Chan* in view of *Nishiwaki* and *Mandelbaum* in view of *Nishiwaki* do not establish prima facie cases of obviousness with respect to claim 1 and claims 2 and 7-17 which depend therefrom. Further, the cited art of *Menezes* or *Schneier* does not cure the deficiencies of the aforementioned references.

b. Claims 21, 25-37, and 39

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining the digital document, the encrypted session key and an independently verifiable data record of each intended recipient at a printout station," as recited in claim 21, since the document store is not co-located with a printer in *Chan*. *Chan* also teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient or group of intended recipients proves their identity.

With regard to *Nishiwaki*, it teaches that a printer unit sends to a host device the identification of a bin where a document is deposited and either provides a personal identification number for the bin or the personal identification number is provided by the sender of the document which does not provide proof of the identity of an intended

Serial No.: 09/918,188  
Art Unit: 2137

recipient, as described in the claim. See col. 6, lines 23-65. Accordingly, *Chan* or *Nishiwaki* fails to teach or suggest "requesting proof of each intended recipient's identity at the printout station using data in the independently verifiable data record of the intended recipient; receiving proof of each intended recipient's identity in the form of a second token uniquely related to the first token; and decrypting the encrypted session key with the second token, decoding the digital document with the decrypted session key, and releasing the document." Likewise, *Carman* describes a variety of encryption techniques, but fails to teach or suggest a printing approach, as claimed, where each intended recipient proves their identity before a document intended for the recipients is allowed to be released at a printout station. Accordingly, the proposed combination of *Chan* in view of *Nishiwaki* in further view of *Carman* does not establish a prima facie case of obviousness with respect to claim 21 and claims 22-37 and 39 which depend therefrom..

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to a document intended for a group of intended recipients by checking proof of identity of the whole group before the document is released. In this respect, *Schneier* and *Carman* are also inadequate in teaching or suggesting these features. For at least these reasons, the proposed combination of *Mandelbaum* in view of *Schneier* in further view of *Carman* does not establish a prima facie case of obviousness with respect to claim 21 and claims 22, 25-37, and 39 which depend therefrom.

c. Claim 40

As previously mentioned, *Mandelbaum* and *Chan* do not suggest or teach an approach for controlling access to a document intended for a group of intended recipients by checking proof of identity of the whole group before the document is released. In this respect, *Carman* is also inadequate in teaching or suggesting these features. For at least these reasons, the proposed combination of *Mandelbaum* in view of *Carman* and *Chan* in view of *Carman* does not establish prima facie cases of obviousness with respect to claim 40.

d. Claims 41-43 and 48

Applicants respectfully submit that independent claim 41 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest "one or more lockable compartments

Serial No.: 09/918,188  
Art Unit: 2137

and the device is arranged to print out the document as received and place it in one of the compartments, wherein the controller is arranged to release the locked compartment containing the document, once the intended recipient has proved their identity," where the "controller [is] for releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token," as recited in claim 41.

*Chan* teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient or group of intended recipients proves their identity.

With regard to *Nishiwaki*, it teaches that a printer unit sends to a host device the identification of a bin where a document is deposited and either provides a personal identification number for the bin or the personal identification number is provided by the sender of the document. Neither of these provides proof of the identity of an intended recipient, as described in the claim. See col. 6, lines 23-65. Accordingly, the proposed combination of *Chan* in view of *Nishiwaki* fails to teach or suggest releasing a document when an intended recipient has proved their identity.

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to already printed documents. For example, *Mandelbaum* teaches that a user is to be present at a print unit for the document to be printed. Therefore, *Mandelbaum* provides no motivation for having a user present when the document is being printed and then instead of allowing the user to access the document, having the printed document deposited in a locked compartment at the print unit so that the user must identify himself or herself again. Further, the inadequacies of the *Nishiwaki* reference, as described above, also apply for a proposed combination with *Mandelbaum*.

For at least these reasons, the proposed combinations of *Chan* in view of *Nishiwaki* and *Mandelbaum* in view of *Nishiwaki* do not establish prima facie cases of obviousness with respect to claim 41 and claims 42-43 and 48 which depend therefrom.

e. Claims 49 and 51-53

Applicants respectfully submit that independent claim 41 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest "one or more lockable compartments

Serial No.: 09/918,188  
Art Unit: 2137

and the device is arranged to print out the document as received and place it in one of the compartments, wherein the controller is arranged to release the locked compartment containing the document, once the intended recipient has proved their identity," where the "controller [is] for releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token," as recited in claim 49.

*Chan* teaches that a document is forwarded from a print server to a printout station after the recipient identifies himself or herself at the printout station. Accordingly, *Chan* does not teach or suggest that a document is retained at the printout station such that it is released after an intended recipient or group of intended recipients proves their identity.

With regard to *Nishiwaki*, it teaches that a printer unit sends to a host device the identification of a bin where a document is deposited and either provides a personal identification number for the bin or the personal identification number is provided by the sender of the document which does not provide proof of the identity of an intended recipient, as described in the claim. See col. 6, lines 23-65. Accordingly, the proposed combination of *Chan* in view of *Nishiwaki* fails to teach or suggest releasing a document when an intended recipient has proved their identity.

Similarly, *Mandelbaum* is apparently limited to at most a system for controlling the printing of documents at a facsimile apparatus and does not suggest or teach an approach for controlling access to already printed documents. For example, *Mandelbaum* teaches that a user is to be present at a print unit for the document to be printed. Therefore, *Mandelbaum* provides no motivation for having a user present when the document is being printed and then instead of allowing the user to access the document, having the printed document deposited in a locked compartment at the print unit so that the user must identify himself or herself again. Further, the inadequacies of the *Nishiwaki* reference, as described above, also apply for a proposed combination with *Mandelbaum*.

For at least these reasons, the proposed combinations of *Chan* in view of *Nishiwaki* and *Mandelbaum* in view of *Nishiwaki* do not establish prima facie cases of obviousness with respect to claim 49 and claims 51-53 which depend therefrom.

f. Claims 57, 59, and 63

All of the claimed features of independent claim 54 are not taught and suggested by *Chan* or *Mandelbaum*, as previously discussed. Further, the cited art of *Schneier* and

Serial No.: 09/918,188  
Art Unit: 2137

*Auerbach* fails to cure the deficiencies of the *Chan* reference in suggesting or teaching all of the claimed features in claim 54 and claims 57, 59, & 63 which depend therefrom. Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Chan* or *Mandelbaum* with *Schneier* or *Auerbach* has not been made. Therefore, the rejections of claims 57, 59, and 63 should be withdrawn.

g. Claims 23-24, 50 and 64-65

Claims 23-24, 50, and 64-65 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

**CONCLUSION**

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
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